

AUG 22 2006

Docket No. F-6817

Ser. No. 09/762,530

**REMARKS**

Claims 11, 16-19, 21-32 are now pending, including independent claim 11, 27 and 32 of which Claim 32 is new.

The Examiner has rejected the claims under 35 USC §103(a) as being unpatentable over Marchal (GB 2063710) and further rejected claims 29-30 in view of Marchal as modified by Su (USPN 5462782). Claim 31 has been rejected under 35 USC §103(a) as being unpatentable over Marchal.

The Examiner asserts that it would be obvious to modify the structure of Marchal to use an adhesive having a lesser bonding strength on one side as compared to the other side (as recited in independent claims 11, 27 and 32) in view of the patterns 11A1 in the reference providing a lower adhesive strength to that structure and in view of routine experimentation. Moreover, the Examiner asserts that while a sheet width of 350 mm as recited in claims 11 and Claim 32 is not provided in the art, such feature would be otherwise obvious based on routine experimentation. Applicant asserts the following in view of this position by the Examiner.

A rejection based on what is obtainable through routine experimentation is only appropriate where an optimal subgroup is selected from a generic group

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disclosed in the prior art reference. *In re Aller*, 220 F.2d 454, 456, 105 U.S.P.Q. 223, 235 (C.C.P.A. 1955) (selecting an optimal temperature range within a disclosed working range was not patentable). Here, the reference also fails to teach providing a different coating strength based on the coating itself apart from the coating placement or configuration and the reference fails to teach a structural range which includes 350 mm of both first and second adhesive coatings (top and bottom of the adhesive tape). Accordingly, the rejection is not proper.

Furthermore, a rejection based on section 103(a) is only appropriate where the primary reference does not lead away from a modification suggested by the Examiner. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983) (a “reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention”); *In re Leonard R. Kahn*, 441 F.3d 997 (Fed. Cir. 2006) (a reference teaches away when the skilled artisan would be “discouraged from following the path set out in the reference, or would be led in a direction divergent from the path taken by the applicant”); *In re Ratto*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959) (references cannot be combined so as to change a principle of operation of the primary reference).

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Here, Marchal is directed to a double sided tape where the adhesive on both sides comprises a "very high bonding power". *Marchal* at line 79. Each adhesive is "equally powerful". *Id.* at line 107. To weaken the bonding power of the tape on one side, the reference provides patterns or holes 11A1 or 21. One following the teachings of Marchal would not be motivated to obviate the use of the patterns and holes and rather use an adhesive having a "lower adhesive strength" (claim 1), such as with the application of two different adhesives (claim 18) or adhesives having different strengths because of being formed by different application rates (claim 17). Such a modification to Marchal obviates the principle operation and indeed the entire need for the Marchal invention which seeks to modify the strength of "equally powerful" adhesives disposed on each surface of the tape. Accordingly, the modification contemplated by the Examiner is not appropriate.

Moreover, in reviewing Marchal, only one surface contains a planar coating of the adhesive while the invention recited in independent claims 1, 27 and 32 provides a planar coating over the entire surface of both the top and bottom of the backing layer. As indicated, providing a planar coating to both sides of the Marchal structure contradicts the purpose of the reference and is thus not appropriate. Furthermore, when referring to Fig. 3 of Marchal, the Examiner is incorrect when asserting that in this figure illustrates a planar *bottom* surface entirely coated with adhesive. In Fig. 3, the pressure-sensitive adhesive 11A is formed from

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several strips of adhesive 11A1 and strips that are free from adhesive 11A2. The pressure-sensitive adhesive 11A shown in Fig. 3 of Marchal on top of the (reversed) adhesive tape actually forms the bottom surface of this adhesive tape. Fig. 3 of Marchal shows the adhesive tape for clarity reasons in a reversed way. Thus, the Marchal reference fails to teach at least the feature of *"a second pressure-sensitive adhesive coating coated on the bottom surface of said backing layer, said coated pressure-sensitive adhesive bottom surface of said backing layer being planar"* as currently recited in independent claims 11 and 32. Accordingly, Marchal fails to teach each recited limitation so that the rejection is not proper.

Based on the above, Applicant asserts that the claims are in a condition for allowance and a notice of allowance is respectfully solicited.

Furthermore, the Examiner appears to maintain a rejection against cancelled Claim 14 (see page 4 and 5 of the Office Action). Applicant respectfully requests the Examiner remove this mooted rejection.


Applicant respectfully requests a three month extension of time for responding to the Office Action. The fee of \$510.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

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